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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,589	03/29/2001	Takashi Sato	70102	3507

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MCGLEW & TUTTLE, PC
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SCARBOROUGH, NY 10510-0827

EXAMINER

LASTRA, DANIEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,589

Applicant(s)

SATO, TAKASHI

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/14/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-22 have been examined. Application 09/821,589 (METHOD OF PROVIDING INFORMATION AND SYSTEM USING THE METHOD) has a filing date 03/29/2001 and foreign priority date 02/28/01.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-10 and 12-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Erlichman (U.S. 6,790,138).

As per claim 1, Erlichman teaches:

A method of providing information with which a computer of a party providing information on commodities, services, advertisements and the like and a plurality of terminals of parties receiving information on commodities, services, advertisements and

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the like are connected to a network, and said computer of a party providing information provides information on commodities, services, advertisements and the like to said terminals of parties receiving information over said network, wherein said computer of a party providing information provides advertisements of one or a plurality of corporations and also provides quizzes corresponding to said advertisements of said corporations, and said terminals of parties receiving information input answers to said quizzes provided by said computer of a party providing information and also input identification numbers for distinguishing contestants (see column 3, lines 30-35; column 6, line 25 – column 7, line 14; column 8, lines 53-67).

As per claim 2, Erlichman teaches:

A method of providing information according to claim 1, wherein said corporations include non-profit organizations (see column 13, lines 15-16).

As per claim 3, Erlichman teaches:

A method of providing information according to claim 2, wherein said non-profit organizations include local self-governing bodies (see column 13, lines 15-16). Erlichman does not expressly teach local self-governing, however it would be inherent that self-governing bodies charities institutions would use the Erlichman system to advertise themselves. This feature would not patentably distinguished the claimed invention from the prior art.

As per claim 4, Erlichman teaches:

A method of providing information according to claim 1, wherein said computer of a party providing information notifies said terminals of parties receiving information whether said answers to said quizzes are correct or not (see column 6, lines 25-67).

As per claim 5, Erlichman teaches:

A method of providing information according to claim 1, wherein said computer of a party providing information provides information relating to said answers to said quizzes to said terminals of parties receiving information (see column 6, lines 25-67).

As per claim 6, Erlichman teaches:

A method of providing information according to claim 5, wherein said information relating to said answers to said quizzes includes information on commodities, services, advertisements and the like relating to advertisements that the contestants of said quizzes see (see column 6, lines 26-67).

As per claim 7, Erlichman teaches:

A method of providing information according to claim 1, wherein said computer of a party providing information provides said quizzes and, at the same time, provides a questionnaire to said terminals of parties receiving information, and collects answers to said questionnaire (see column 6, lines 50-67).

As per claim 8, Erlichman teaches:

A method of providing information according to claim 7, wherein in said questionnaire, first quizzes are provided when said terminals of parties receiving information access said computer of a party providing information (see figure 3b), second quizzes are provided when advertisements provided by said computer of a party

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providing information are clicked on said terminals of parties receiving information (see figure 3a), third quizzes are provided when said terminals of parties receiving information enter a contest for prizes provided by said computer of a party providing information, and said computer of a party providing information thus collects answers to respective items of said questionnaire (see column 9, line 45 – column 10, line 6).

As per claim 9, Erlichman teaches:

A method of providing information according to claim 7 wherein said computer of a party providing information performs predetermined data analysis based on said collected answers to said questionnaire (see column 1, lines 35-60).

As per claim 10, Erlichman teaches:

A method of providing information according to claim 1 wherein said terminals are computers (see column 11, lines 45-65).

As per claim 12, Erlichman teaches:

A system for providing information with which a computer of a party providing information on commodities, services, advertisements and the like and a plurality of terminals of parties receiving information on commodities, services, advertisements and the like are connected to a network, and said computer of a party providing information provides information on commodities, services , advertisements and the like to said terminals of parties receiving information over said network, wherein said computer of a party providing information is provided with fifth means for providing advertisements of one or a plurality of corporations and sixth means for providing quizzes corresponding

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to said advertisements of said corporations. Claim 12 contains the same limitations as claim 1 therefore the same rejection is applied.

As per claim 13, Erlichman teaches:

A system for providing information according to claim 12, wherein said corporations include non-profit organizations. Claim 13 contains the same limitations as claim 2 therefore the same rejection is applied.

As per claim 14, Erlichman teaches:

A system for providing information according to claim 12, wherein said non-profit organizations include local self-governing bodies. Claim 14 contains the same limitations as claim 3 therefore the same rejection is applied.

As per claim 15, Erlichman teaches:

A system for providing information according to claim 12 wherein said computer of a party providing information is provided with seventh means for notifying said terminals of parties receiving information whether said answers to said quizzes are correct or not. Claim 15 contains the same limitations as claim 4 therefore the same rejection is applied.

As per claim 16, Erlichman teaches:

A system for providing information according to claim 12 wherein said computer of a party providing information is provided with eighth means for notifying information relating to said answers to said quizzes to said terminals of parties receiving information. Claim 16 contains the same limitations as claim 5 therefore the same rejection is applied.

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As per claim 17, Erlichman teaches:

A system for providing information according to claim 16 , wherein said information relating to said answers to said quizzes includes information on commodities, services, advertisements and the like relating to advertisements that the contestants of said quizzes see. Claim 17 contains the same limitations as claim 6 therefore the same rejection is applied.

As per claim 18, Erlichman teaches:

A system for providing information according to claim 12 wherein said computer of a party providing information is provided with ninth means for providing quizzes and, at the same time, providing a questionnaire to said terminals of parties receiving information, and collecting answers to said questionnaire. Claim 18 contains the same limitations as claim 7 therefore the same rejection is applied.

As per claim 19, Erlichman teaches:

A system for providing information according to claim 18 , wherein with said ninth means, first quizzes are provided when said terminals of parties receiving information access said computer of a party providing information, second quizzes are provided when advertisements provided by said computer of a party providing information are clicked on said terminals of parties receiving information, third quizzes are provided when said terminals of parties receiving information enter a contest for prizes provided by said computer of a party providing information, and said computer of a party providing information thus collects answers to respective items of said questionnaire.

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Claim 19 contains the same limitations as claim 8 therefore the same rejection is applied.

As per claim 20, Erlichman teaches:

A system for providing information according to claim 18 wherein said computer of a party providing information is provided with tenth means for performing predetermined data analysis based on said collected answers to said questionnaire. Claim 20 contains the same limitations as claim 9 therefore the same rejection is applied.

As per claim 21, Erlichman teaches:

A system for providing information according to claim 12, wherein said terminals are computers. Claim 21 contains the same limitations as claim 10 therefore the same rejection is applied.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erlichman (U.S. 6,790,138) in view of Mankovitz (U.S. 6,253,069).

As per claim 11, Erlichman teaches:

A method of providing information according to claim 1 but fails to teach wherein said terminals are cellular phones. However, Mankovitz teaches a system that permits users to participate in contests and quizzes using cellular phones (see column 3, lines

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54-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Erlichman would allow users to participate in contests, puzzles or quizzes using cellular phones, as taught by Mankovitz. This feature would give users of the Erlichman system other avenues beside the Internet to participate in the Erlichman's prize system.

As per claim 22, Erlichman teaches:

A system for providing information according to claim 12, but fails to teach wherein said terminals are cellular phones. Claim 22 contains the same limitations as claim 11 therefore the same rejection is applied.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

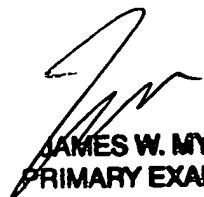
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra

September 2, 2004


JAMES W. MYHRE
PRIMARY EXAMINER